

- Claims 1-12, 21-30, 41-50 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kelly et al. et al. (U.S. 5,584,763) in view of Stotler (U.S. 1,257,045).

5    **Election**

Applicants confirm the provisional election made without traverse on June 13, 2002 to prosecute the inventions of Group 1, claims 1-12, 21-30, and 41-50.

**Drawings**

10        An amended sheet of drawing is attached showing the “additional animated figure” being claimed in claim 8 and the “additional animated element” being claimed in claim 9. Applicants submit that no new matter is introduced with the amended sheet of drawing. The additional animated figure and element were described in several locations of the application, including page 12, lines 12-17 of the specification and in claims 8 and 9.

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**Interview**

Applicants sincerely appreciate the courtesies extended by Examiner Frederick Nicolas during a telephone interview conducted on August 14, 2002. During the interview, Applicants’ attorneys presented several arguments including: (1) improper combination of Kelly et al. and Stotler, (2) that Stotler is non-analogous art, (3) that Kelly et al. does not teach modifying the pointer disclosed with an animated object or an animated element, (5) that Kelly et al. and Stotler do not disclose a processor configured to generate a random number, and (6) that Kelly et al. and Stotler do not disclose an animated gaming system activated by a bonus event. Although no agreement was made between Examiner Nicolas and Applicants’ attorneys, Examiner Nicolas



indicated that Kelly et al. and Stotler do not appear to disclose a processor configured to generate a random number and an animated gaming system activated by a bonus event. Examiner Nicolas further indicated that he would perform a new search in light of Applicants' attorneys' arguments.

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#### **Review of certain aspects of the invention**

In a preferred embodiment, the animated display system of the present invention comprises a housing, an animated figure, and an animated element. The housing for the animated gaming system include a symbol, which represents a prize. The animated figure  
10 preferably has a three-dimensional form. The animated element is operatively coupled to the animated figure and is controlled by a control system, which manages the operations of the animated figure and the animated element. The operations may include positioning the animated element to identify the prize.

One of the advantages of the preferred embodiment above is that it provides a gaming  
15 device having an animated figure that identifies a prize. The animated gaming device may be used in combination with another gaming device and may serve to provide a bonus game. Bonus games increase the excitement and enjoyment experienced by players. This attracts more players to the game and encourages players to play longer. When gaming devices attract more players and the players play longer, they tend to be more commercially successful relative to  
20 other gaming devices.

#### **Response to 35 U.S.C. §103(a) rejections**

Applicants submit claims 1-12, 21-30, 41-50, and new claims 51 and 52 are patentable over Kelly et al. in view of Stotler for the following reasons.



**The combination of Kelly et al. and Stotler is improper.**

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. MPEP §2143,

5 See also *In re Rouffet*, 149 F.3d 1350, 1357. The applicants submit that the Office has not established a *prima facie* case of obviousness because there is no suggestion or motivation to combine Kelly et al. and Stotler as discussed below.

**The references teach away from combining features of Stotler with Kelly et al.'s because**  
10 **Kelly et al. is intended for play in an arcade, whereas Stotler is a game not typically played in an arcade environment.**

Column 1, lines 8-10 of Kelly et al. reads, "This invention relates to games normally played in an arcade environment, and more particularly to games which include rotating pointers to indicate a score." Arcade games require the ability to charge players for playing their games  
15 so that the arcade owner can generate income from the games.

Stotler, on the other hand, discloses a game having a mechanical structure adapted to be set in rotating motion by the player. As the mechanical structure comes to rest, the mechanical structure will operate to select marked counters or indicia. Applicants submit that Stotler's is not adapted for use in an arcade because Stotler does not teach or suggest any means of charging  
20 a player for playing the game. Additionally, the game in Stotler appears to be intended as a tabletop game similar to most board games and not arcade games. Therefore, someone of ordinary skill in the art would not think to combine Kelly et al. with Stotler.



**Kelly et al. teaches away from adapting Stotler's game, as the game outcome in Kelly et al. is determined by the player's skill in *stopping* the pointers, whereas the game outcome in Stotler is determined by the player's skill in *starting* the movement of the device.**

Column 1, lines 32-36 of Kelly et al. reads, "It is believed that an arcade game which  
5 incorporates skilled operation from a player to stop multiple pointers would remain more  
interesting to players and generate greater revenues for the arcade owner." Column 2, lines 42-  
44 of Kelly et al. further reads, "The player must exercise skill and control in deciding when to  
stop the pointers to receive a high score..." (Emphasis added) In playing the game of Kelly et al.,  
it appears that a player has to set the pointers in motion by pressing a start button, and the player  
10 has to stop the pointers by pressing a stop button. The game appears to encourage the player to  
exercise his skill in stopping the pointer device.

In contrast, Stotler's game appears to encourage the player to exercise his skill in setting  
the device in motion. The player has to gauge the force he must apply to start the device, which  
later dictates the location on which the device will come to rest. The "skill of the operator will  
15 be called into play, to try to spin the device so as to have the magnet come to rest over the  
desired counter." Page 2, lines 33-36. (Emphasis added) Therefore, Kelly et al. teaches away  
from incorporating Stotler's game, as Kelly et al. requires exercise of skill and control in  
deciding when to stop the pointers.

In sum, there is no suggestion or motivation, either in Kelly et al. or in Stotler or in the  
20 knowledge generally available to one of ordinary skill in the art to modify or to combine  
reference teachings of Kelly et al. and Stotler. Applicants respectfully request the withdrawal of  
35 U.S.C. §103(a) rejections for claims 1-12, 21-30, 41-50 and allowability of new claims 51-54  
in light of Kelly et al. and Stotler.



**Stotler is non-analogous art**

In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned. MPEP 2141.04(a),

5 See also *In re Oetiker*, 977 F.2d 1443.

Applicants submit that Stotler should not be relied on as a reference and as a basis for rejection of the applicants' invention because the Stotler does not pertain to gaming devices. Gaming devices typically require fees or wagers to play their games. No fee or wager is required to play Stotler's game. Additionally, Stotler does not award any prize, whereas typical gaming  
10 devices have a prize award. Therefore, Stotler is non-analogous to the act of the present invention. Withdrawal of 35 U.S.C. 103(a) rejections on claims 1-12, 21-30, and 41-50 based on Stotler is respectfully requested.

**The cited references, even when improperly combined, do not teach or suggest all the  
15 claim limitations.**

MPEP §2143 states that the prior art reference or references when combined must also teach or suggest all the claim limitations. See also *In re Royka*, 490 F.2d 981. Notwithstanding the Applicants' arguments against improper combination of references, Applicants submit that even if the cited references were combined, the cited references do not teach or suggest all the  
20 claim limitations as discussed below.



**Kelly et al. and Stotler do not teach or suggest a processor configured to generate a random number, which determines the location of an animated element.**

Kelly et al. is a game apparatus having a display with indicia provided thereon and multiple pointers rotatable in opposite directions. Control mechanisms allow a player to start and stop the rotation of the pointers. A game score is calculated by summing numeral indicia pointed to by the pointers. Kelly et al. discloses a microprocessor, which serves to record scores, control the speed of the motors rotating the pointers, control the rotation of each of the pointers, the conditions required to receive an award, and the conditions required for a player to win a progressive bonus.

While Kelly et al. discloses a microprocessor, the microprocessor in Kelly does not have a feature that generates a random game outcome. Kelly et al. is a game requiring player's skill in stopping the pointers. As such, the game outcome in Kelly et al. is dictated by the player's skill, and not by a processor that generates random numbers. With regard to Stotler, Stotler simply does not disclose any processors.

#### **Claims 2, 11, 12, 21, 27-29, 41, 48 and 49**

Claims 2, 11, 12, 21, 27-29, and 41 claims the processor and/or the random number generator described above as not being taught or suggested by Kelly et al. and Stotler even if Kelly et al. and Stotler were combined. Withdrawal of the 35 USC 103(a) rejections on these claims is respectfully requested.

#### **Dependent Claims 22-30**

By virtue of claim dependency to claim 21, dependent claims 22-30 also claims the processor described above as not being taught or suggested by Kelly et al. and Stotler even if



Kelly et al. and Stotler were combined. Withdrawal of the 35 USC 103(a) rejections on these claims is respectfully requested.

**Dependent Claims 42-50**

5 By virtue of claim dependency to claim 41, dependent claims 42-50 also claims the processor described above as not being taught or suggested by Kelly et al. and Stotler even if Kelly et al. and Stotler were combined. Withdrawal of the 35 USC 103(a) rejections on these claims is respectfully requested.

10 **New Claims 51 and 53**

New claims 51 and 53 claim the processor and/or the random number generator described above as not being taught or suggested by Kelly et al. and Stotler even if Kelly et al. and Stotler were combined. Allowances of new claims 51 and 53 are respectfully requested.

15 **The combination of Kelly et al. and Stotler do not teach or suggest an animated gaming system triggered by a bonus event.**

Kelly et al. appears to allow a player to play a game, which involves starting the pointer in motion and stopping the pointer to obtain a score. Kelly et al. also appears to disclose a progressive bonus apparatus. Although Kelly et al. discloses a first gaming device and a  
20 progressive bonus apparatus, Kelly does not disclose a first gaming device and an animated gaming system. Kelly et al. further does not disclose an animated display system activated by a bonus event. A player playing the device disclosed in Kelly et al. may play for the progressive prize without having to qualify for progressive game participation. On the other hand, certain

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embodiments of the present invention may require achieving a particular outcome prior to playing the animated gaming system.

Stotler, on the other hand, does not disclose any gaming device. No deposit is required to play Stotler's game. Gaming devices typically require deposits to play their games.

5 Additionally, Stotler does not award any prize, whereas typical gaming devices have a prize award. Although Stotler may have a three dimensional pointer, Stotler does not have an animated gaming system. Stotler does not further disclose an animated gaming system activated by a bonusing event.

10 **Claim 21**

Claim 21 claims an animated gaming system triggered by a bonusing event, which is described above as not being taught or suggested by Kelly et al. and Stotler even if Kelly et al. and Stotler were combined. Withdrawal of the 35 USC 103(a) rejections on claim 21 is respectfully requested.

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**Dependent Claims 22-30**

By virtue of claim dependency to claim 21, dependent claims 22-30 also claims the animated gaming system being triggered by a bonusing event, which is described above as not being taught or suggested by Kelly et al. and Stotler even if Kelly et al. and Stotler were  
20 combined. Withdrawal of the 35 USC 103(a) rejections on these claims is respectfully requested.





**New Claims 52 and 54**

New claims 52 and 54 claim the bonus feature, which is described above as not being taught or suggested by Kelly et al. and Stotler even if Kelly et al. and Stotler were combined. Allowances of new claims 52 and 54 are respectfully requested.

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**CONCLUSION**


The Office has not presented a combination of references that disclose each and every element of claims 2, 11, 21-30, 41-50, as required by a large body of law. Withdrawal of the 35 USC 103(a) rejections on claims 2, 11, 21-30, and 41-50 is respectfully requested. Applicants  
10 also submit and request allowance of new claims 51-54, as they claim limitations not disclosed in Kelly et al. and Stotler.


The amendments to the claims above have not been made to overcome the rejections. The applicants believe that the original claims are patentable over the cited reference. The applicants make the amendments to obtain an early allowance of the application. The applicants  
15 further make the amendments to correct certain typographical errors and to improve the readability of the claims.

For all of the above reasons, the applicants submit that the present application is in condition for allowance. If the examiner has any questions regarding the application or this response, the examiner is encouraged to call the applicants' attorney, Rolando J. Tong, at (775)  
20 826-6160.

Respectfully submitted,

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Rolando J. Tong, Attorney for Applicant(s)  
Registration Number: 47,140



**VERSION WITH MARKINGS SHOWING CHANGES MADE**

The applicants request the cancellation of claims 2 and 26 without prejudice or disclaimer.

The applicants request the Office to enter the following amendments.

- 5     1.     (Amended Once) An animated gaming system, comprising:
- a housing [for said animated gaming system], [said] the housing having at least
- one symbol [which] that represents at least one prize;
- an animated figure having a three-dimensional form, the animated figure being
- coupled to the housing; [and]
- 10               an animated element operatively coupled to [said] the animated figure, [said] the
- animated element configured to identify [said] the at least one prize; and
- a processor in communication with the animated figure, the processor being
- configured to generate a random number, the processor being further configured to cause
- the animated element to identify the at least one prize if the random number is a
- 15               predetermined number or within range of predetermined numbers.
21.     (Amended Once) A gaming system, comprising:
- a first gaming device, the first gaming device being adapted to allow a player to
- play a game;
- 20               an animated gaming system configured to receive communications from [said] the
- first gaming device, [said] the animated gaming system including an animated figure with
- a three-dimensional form;
- an animated element operatively coupled to [said] the animated figure; and

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a processor in communication with the animated figure, the processor being  
configured to control [said] the animated figure and [said] the animated element, wherein  
the animated gaming system is activated by a bonus event associated with the first  
gaming device.

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The applicants request the Office to enter the following new claims.

55. (New) An animated gaming system comprising:

- (A) an animated figure having a three-dimensional form;
- (B) at least one symbol representing at least one prize;
- 10 (C) an animated element operatively coupled to the animated figure, the animated  
element being configured to indicate the at least one symbol, wherein the symbol  
is positioned to be indicated by the animated element; and
- (D) a processor in communication with the animated figure, the processor being  
configured to generate a random number and cause the animated element to  
15 indicate the at least one symbol depending on the random number.

56. (New) A gaming system comprising:

- (A) a first gaming device, the first gaming device being adapted to allow a player to  
play a game, the first gaming device being configured to produce a bonus event;
- 20 (B) an animated gaming system in communication with the first gaming device, the  
animated gaming system comprising an animated figure with a three-dimensional  
form and an animated element operatively coupled to the animated figure,  
wherein the animated gaming system is activated when the bonus event occurs.



57. (New) A gaming system comprising:

- (A) at least one symbol;
- (B) at least one lifelike structure, the lifelike structure being configured to move toward the at least one symbol to identify at least one prize, wherein the at least one symbol is positioned to be indicated by the lifelike structure;
- (C) a processor, the processor being in communication with the lifelike structure, the processor being configured to cause the movement of the lifelike structure according to a random event.

58. (New) A gaming system comprising:

- (A) a gaming device having a set of symbols that displays a game outcome, the gaming device being configured to allow a player to play a game and obtain a game outcome; and
- (B) a display device having at least one symbol representing a bonus prize and a lifelike structure, the display device being configured to be activated by a bonus signal from the gaming device,

wherein the gaming device sends the bonus signal to the display device upon a bonus event and the lifelike structure is configured to identify the at least one symbol.

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